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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/621,154	07/16/2003	James L. Sumiejski	3218R	1207
26645 7590 07/10/2008 THE LUBRIZOL CORPORATION ATTN: DOCKET CLERK, PATENT DEPT. 29400 LAKELAND BLVD. WICKLIFFE, OH 44092				
EXAMINER RONESL VICKERY M				
ART UNIT		PAPER NUMBER		
1796				
NOTIFICATION DATE		DELIVERY MODE		
07/10/2008		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

Office Action Summary

Application No.

10/621,154

Applicant(s)

SUMIEJSKI ET AL.

Examiner

VICKEY RONESI

Art Unit

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 March 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2, 7-20, 27 and 28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 7-20, 27 and 28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(c), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(c) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3/26/2008 has been entered.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior office action.

Claim Rejections - 35 USC § 103

3. Claims 1, 2, 7-20, 27, and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ward (WO 00/70001).

Ward discloses a lubricating composition for use in transmissions (abstract, page 3, lines 19-31) preparing by mixing the following ingredients (page 22, lines 23-25): 0.05-5 wt % (page 18, lines 7-8) phosphorus anti-wear additive including preferably a phosphite ester having alkyl groups with at least 8 carbons atoms (page 15, lines 26-29) or mixtures of alkyl groups with C₁₈, C₂₀, C₂₂, and C₂₄ (page 16, lines 30-34); 0.1-0.45 wt % (page 20, lines 22-24) one or more friction modifiers including isostearic acid condensation products of polyamines such as tetraethylene pentamine (exemplified, Supplement B in Table 4) and diaminomethane including those containing amide and imidazoline functional groups (page 18, lines 20-23; page 19, lines 8-31) and borated epoxides prepared by reacting hydrocarbyl epoxide with boric acid or boron

trioxide (page 19, line 32 to page 20, line 21; page 23, table); 0.1-5 wt % (page 9, lines 15-17) borated dispersant from the reaction of polyisobutylene-substituted succinic anhydride with polyethyleneamines (page 9, lines 19-36; page 23, lines 10-12); and at least 80 wt % (page 4, lines 10-15) oil of lubricating viscosity of API Groups II or III (page 4, lines 10-26) or Group (IV (page 4, line 37); and other additives (page 20, lines 31-37). A concentrate can be prepared comprising 10-50 parts by weight lubricating oil (page 21, lines 11-30). Ward teaches on page 3, lines 19-31, that its lubricant composition is useful as automatic and manual transmission fluids and as transaxle lubricants.

Ward does not exemplify a composition which each of the presently claimed elements, however, it exemplifies a condensation product of isostearic acid and tetraethylene pentamine as the friction modifier and prefers the use phosphorus anti-wear additive including preferably a phosphite ester having alkyl groups with at least 8 carbons atoms (page 15, lines 26-29) or mixtures of alkyl groups with C₁₈, C₂₀, C₂₂, and C₂₄.

Even so, while Ward does not exemplify a lubricant composition comprising each and every one of the presently claimed ingredients, this does not negate a finding of obviousness under 35 USC 103 since a preferred embodiment such as an example is not controlling. Rather, all disclosures "including unpreferred embodiments" must be considered. *In re Lamberti* 192 USPQ 278, 280 (CCPA 1976) citing *In re Mills* 176 USPQ 196 (CCPA 1972). Therefore, it would have been obvious to one of ordinary skill in the art to utilize a lubricant composition comprising a lubricating oil and the presently claimed additives given that Ward teaches each one, absent evidence of unexpected or surprising results.

4. Claims 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ward (WO 00/70001) in view of Farnig et al (US 5,006,270).

The discussion with respect to Ward in paragraph 3 above is incorporated here by reference.

Ward does not explicitly teach the use of an optional borate ester like presently claimed, however, it is open to the use of antioxidants (page 20, line 31).

Farnig et al discloses a lubricant composition and teaches that borate esters such as tributyl borate (col. 3, lines 53-65) have excellent multifunctional/antioxidant activity (col. 1, lines 16-19).

Given that Ward is open to antioxidants and further given that borate esters such as tributyl borate provide for excellent antioxidant properties in lubricant compositions as taught by Farnig et al, it would have been obvious to one of ordinary skill in the art to utilize tributyl borate in the composition of Ward to impart desired antioxidant properties.

Response to Arguments

5. Applicant's arguments filed 3/26/2008 have been fully considered but they are not persuasive. Specifically, applicant argue (A) that the declaration from Dr. Patterson filed on 3/26/2008 establishes that a marked improvement is had by using the condensation product of a fatty acid with an ethylenepolyamine compared to other friction modifiers taught by Ward and (B) that the declaration from Mr. Sumiejski filed 5/1/2006 serves to establish unexpected and surprising results for an alkyl phosphite with an alkyl group containing 12-30 (or 14-20) carbon

atoms in a lubricating composition when compared to a lubricating composition containing an alkyl phosphite with an alkyl group containing 6 carbon atoms.

With respect to (A), the comparative showings are not convincing as being defective as comparative examples 3 and 4 with respect to S1/D seem to fall within the preferred range of 0.9-1.0. It also appears that the amount of friction modifier could be changed to control the effect of friction and that it would have been obvious to one of ordinary skill in the art to utilize suitable amounts of friction modifier (whether more or less, both of which fall within the amount of 0.1-0.45 wt % as taught by Ward) to control the S1/D values. Case law holds that whether the unexpected results are the result of unexpectedly improved results or a property not taught by the prior art, the “objective evidence of nonobviousness must be commensurate in scope with the claims which the evidence is offered to support.” In other words, the showing of unexpected results must be reviewed to see if the results occur over the entire claimed range (i.e., scope). *In re Clemens*, 622 F.2d 1029, 1036, 206 USPQ 289, 296 (CCPA 1980), MPEP 716.02(d).

Furthermore, the data is not reasonably commensurate in scope with the claims given that the data is only for isostearic acid + tetraethylenepentamine (which is not a member of formula III, hydrocarbyl imidazoline) and the claims are drawn to both a hydrocarbyl imidazoline and a hydrocarbyl amide. Case law holds that evidence is insufficient to rebut a *prima facie* case if not commensurate in scope with the claimed invention. *In re Grasselli*, 713 F.2d 731, 741, 218 USPQ 769, 777 (Fed. Cir. 1983). Case law holds that evidence of superior properties in one species insufficient to establish the nonobviousness of a subgenus containing hundreds of compounds. *In re Greenfield*, 571 F.2d 1185, 1189, 197 USPQ 227, 230 (CCPA 1978).

With respect to (B), Ward discloses an alkyl phosphite with at least 8 carbon atoms (page 15, lines 26-29) or mixtures of alkyl groups with C₁₈, C₂₀, C₂₂, and C₂₄ (page 16, lines 30-34). Given that Ward does not teach an alkyl phosphite with 6 carbon atoms in the alkyl group, the data in the declaration has no probative value with respect to Ward.

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vickey Ronesi whose telephone number is (571) 272-2701. The examiner can normally be reached on Monday - Friday, 8:30 a.m. - 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

7/2/2008
vr

/Vickey Ronesi/
Examiner, Art Unit 1796